

54704.8037.US00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

in re the Application of:

Pilch, et al.

Serial No.: 09/945,155

Filed: August 31, 2001

For: Inhibition of Viral Replication By Targeting RNA-DNA Complexes

Group Art Unit: 1597

Examiner: Shengjun Wang

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AMENDMENT TRANSMITTAL

BOX RESPONSES - FEE
Commissioner for Patents
Washington, D.C. 20231

Sir:

Transmitted herewith is an Amendment and Response for the above-identified application, a check in the amount of \$110 for a one-month extension of time, and a postcard.

☒ The Commissioner is authorized to charge Perkins Coie's Deposit Account No. **50-0665** for any fees required under 37 CFR §§ 1.16 and 1.17 that are not covered and to credit any repayments to the same.

Certificate of Mailing

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage in an envelope addressed to the Assistant Commissioner for Patents, Washington, DC 20231.

February 14, 2003
Date of Deposit

Deborah Muench
Deborah Muench

Respectfully submitted,

Perkins Coie LLP

Dated: February 14, 2003

By: *Lauren Sliger*
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In re the Application of:

Pilch et al.

Serial No.: 09/945,155

Filed: August 31, 2001

For: INHIBITION OF VIRAL
REPLICATION BY TARGETING RNA-
DNA COMPLEXES

Examiner: Shengjun Wang

Group Art Unit: 1597

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RESPONSE TO RESTRICTION REQUIREMENT

BOX RESPONSE—FEE
Commissioner for Patents
Washington, D.C. 20231

Dear Examiner:

This paper responds to the three-way restriction requirement, mailed December 17, 2002, for the above-referenced application. Applicants have concurrently requested a one-month extension of time, making this response timely.

The restriction requirement is grouped as follows: Group 1—claim 1 and 10 to an antiviral agent, Group 2—claims 2-9, 11, and 12 to a method of inhibiting reverse transcriptase, and Group 3—claims 13-17 to a method for screening antiviral agents and related kits. Applicants elect Group 2.

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[54704-8037/LA030420.121]

Since the Applicants have chosen Group 2, they are further required “under 35 USC 121 to elect a single disclosed species, even though this requirement is traversed.”

Applicants provisionally elect the species of neomycin with traverse. The five species of aminoglycosides recited in claims 3 and 12 are members of a Markush group. While being directed to separate and distinct inventions, they are sufficiently few and closely related enough that a search and examination of the entire claim can be made without serious burden. Thus, all the members of the Markush group in the claim on the merits must be examined. MPEP § 803.02. Moreover, it is improper to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention.

Furthermore, even if the aminoglycosides were held to be related inventions, in order to justify restriction, it would have to be shown that that at least one of the following exists:

1) separate classification, 2) separate status in the art, or 3) different field of search. MPEP 808.02. The aminoglycosides were classified in the same class and subclass (514, 42+).

There has been no showing that each aminoglycoside enjoys a separate status in the art.

Finally, there has been no showing that that the aminoglycosides have different fields of search.

CONCLUSION

For all of the foregoing reasons, Applicant traverses the species election portion of the restriction requirements. If anything can be done to further this application, please contact the undersigned at 310-788-9900.

Respectfully submitted,

PERKINS COIE LLP

Date: February 14, 2003

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